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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/800,463 03/08/01 AVALLE

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EXAMINER

HM12/0605

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PROFESSIONAL LIMITED LIABILITY COMPANY
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WILLIS, M

ART UNIT

PAPER NUMBER

1619

DATE MAILED:

06/05/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trad marks

Office Action Summary

Application No.

09/800,463

Applicant(s)

AVALLE, NADIA

Examiner

Michael Willis

Art Unit

1619

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claims ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____

DETAILED ACTION

Claims 1-13 are pending. Claims 1-8 are drawn to a cosmetic powder with a coating.

Claim 9 is drawn to a cosmetic composition comprising a coated powder. Claims 10-13 are drawn to a process for preparation of a cosmetic powder.

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. Claims 1, 3, 10, 12, and 13 are rejected for being confusing due to the term "hydroxi". The term appears to be a non-standard spelling of the word "hydroxy". The rejection can be obviated by amending the claims to substitute "hydroxy" for "hydroxi".

5. Claim 3 is rejected for being confusing. The meaning of the phrase "characterised in that comprises" is unclear. The rejection can be obviated by amending the claim to insert "said powder" in between "characterised in that" and "comprises".

6. Claims 7 and 12 are rejected for being vague due to the phrase "functional substances". It is unclear what is meant by the phrase, and the specification does not define or limit the phrase.
7. Claim 8 is rejected for being confusing due to the phrase "vitamins/amino acids". The relationship between vitamins and amino acids is unclear. The rejection can be obviated by amending the claim to read "vitamins and/or amino acids".
8. Any remaining claims are rejected for depending from indefinite base claims.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

10. Claims 1, 2, 3, 9, 10, and 11 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Benoit et al (US Pat. 6, 183,783 B1). Benoit discloses microcapsules comprising materials coated with a polymer and a method for preparing the microcapsules (see abstract and col. 3, lines 5-38). The coating agent includes polymers and copolymers of alpha hydroxycarboxylic acids, including lactic and glycolic acids (see col. 3, line 56 through col. 4, line 52, particularly col. 4, lines 35-37). The material to be coated includes cosmetic products (see col. 4, line 55 through col. 5, line 13). The process of coating the material comprises combining the polymer and the

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material to be coated in an organic solvent followed by removal of the organic solvent by discharging the solvent with carbon dioxide (see col. 3, lines 5-38). Ethyl acetate is disclosed as a solvent for the process (see col. 5, lines 36-49). In example 9, Benoit discloses a process for coating bovine serum albumin with a lactic acid polymer (see col. 8, lines 30-61). Bovine serum albumin is a known component in skin care compositions (see Band et al, US Pat. 5,153,174; col. 1, lines 29-40). The microcapsules of Benoit are used in combination with cosmetic products (see claim 16, col. 10, lines 27-28).

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 1-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Coury et al (US Pat. 5,879,688) in view of Isawa et al (US Pat. 3,969,547) and Benoit et al (US Pat. 6,183,783 B1).

13. Coury teaches hydroxy-acid cosmetics. The cosmetics taught by Coury include polymers of alpha hydroxy acids such as D,L-lactic acid, powders with excipients such as talc and kaolin, pigments, anti-aging additives such as vitamin A, and other additives (see col. 2, lines 20-40; col. 4, lines 1-11; col. 5, line 55 through col. 6, line 26; col. 11, lines 29-51; col. 12, line 66 through col. 13, line 24; col. 14, lines 33-39; col. 16, lines

10-31; col. 15, lines 55-67; col. 16, lines 32-44; and col. 26, lines 32-35). Coury teaches that the powders may be used as cosmetically acceptable vehicles for the hydroxy acid polymers (see col. 12, line 66 through col. 13, line 54). The reference lacks a method and a motivation for coating the alpha hydroxy polymers onto the powder particles.

14. Isawa teaches a method for preparing polymer-coated powder particles. The particles are coated with polymers by dispersing the particles in a solution containing the polymers, followed by addition of a solvent less compatible with the solution to form an emulsion, and removal of the original solvent to yield particles coated with the polymers (see abstract and col. 1, line 37 through col. 2, line 68). The polymers include polyesters (see col. 3, lines 1-17). Suitable solvents include ethyl acetate (see col. 3, lines 18-25). The particles include metal oxides (see col. 3, lines 26-37).

15. Benoit teaches that microencapsulation, or coating particles with polymers, can have various goals, including increasing stability of the active principle, preventing coalescence or agglomeration of the particles, delaying or prolonging the action of the active ingredient, altering the compatibility of the core particle, or to alter the release of the active agent (see col. 1, lines 25-43).

16. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the cosmetic compositions of Coury by the method of coating of the powders with the polymers as taught by Isawa for the expected benefit of increased stability and reduced coalescence of particles as taught by Benoit.


Conclusion


17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Elwakil (US Pat. 6,187,439 B1) discloses encapsulated pigments. Polymers used to encapsulate the pigments include polymers of lactic acid or glycolic acid (see col. 11, lines 4-26).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Willis whose telephone number is (703) 305-1679. The examiner can normally be reached on Monday to Friday from 8:30 a.m. to 5 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diana Dudash can be reached on (703) 308-2328. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-2742 for regular communications and (703) 308-2742 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1234.


Michael A. Willis, Ph.D.
Patent Examiner
June 1, 2001


Michael Hartley
Primary Examiner
Art Unit 1619